



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/753,248 11/22/96 COHEN L 05364.0005

FINNEGAN HENDERSON FARABOW  
GARRETT & DUNNER  
1300 I STREET NW  
WASHINGTON DC 20005-3315

26M2/0909

EXAMINER

NGUYEN, M

ART UNIT	PAPER NUMBER
----------	--------------

2616 8

DATE MAILED:

09/09/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Best Available Copy**

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
--------------------	-------------	-----------------------	------------------

EXAMINER

ART UNIT

PAPER NUMBER

8

DATE MAILED:

This is a communication from the examiner in charge of your application.  
 COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY**

- Responsive to communication(s) filed on 4/25/96.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- Claim(s) 1-22 is/are pending in the application.  
 Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-22 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.  
 received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Art Unit: 2616

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 10 recites the limitation "the pieces of information" and "the means for associating" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Huang (US Patent No. 5416849).

Concerning claims 1-3, Huang teaches a facsimile transmission system comprising a computer readable medium (Fig.5), wherein said computer readable medium including:

- a data corresponding to a pre-formatted form having a group of fields arranged at designated locations on the form (Figs 1B, 1C, 2A);

Art Unit: 2616

- means for receiving data corresponding to a stored pre-formatted form having a group of fields arranged at designated locations on the stored form (Figs.2A, 2C, 2D, 5);

- instructions configured to extract a definition record from received data, the definition record including an ordered listing of identifiers for each of the fields being supplied in received data; populate the group of fields in response to the reception of field identifiers and associated information data to generate a generated form having data corresponding to the designated fields; and transmit a facsimile of the generated form (Figs.1A, 1B, 1C, 7A, 7B; Abstract; col 2, line 22 - col 3, line 12; col 5, line 15 - col 8, line 29; col 8, line 67 - col 10, line 9; col 10, lines 10-26; col 12, lines 8-33; col 14, line 47 - col 15, line 14).

Concerning claims 1-3, Huang teaches data processing system for field extraction of scanned images of document forms and does not mention in details the transmission of the generated form through facsimile machine. However, the intelligent form processor 25 (Fig.5) connects the fax and communication network which can transmit and receive the any form through the telephone line (col 8, line 67 - col 9, line 14). "The provision of a facsimile and a network adapter 320 connecting a telephone facsimile line to the processor 25 enable the receipt of facsimile images in lieu of images provided through the scanner adapter 318. Similarly, the connection of the adapter 320 to a data communications network enables the receipt of existing document image files from the network, in lieu of the production production of such document image files by the scanner 22" (col 10, lines 1-9). It would have been obvious to one skilled in the art at the time the invention was made to consider the transmission of the generated form through

Art Unit: 2616

facsimile machine to transmit and receive different information with or without pre-formatted forms to improve the speed, the cost and the efficiency of the transmission and reception of the facsimile machine, to eliminating pre-printed forms and minimize forms distribution costs.

3. Concerning claims 4-10, 12-14, the system according to claim 3 wherein the received data includes a facsimile telephone number (12bF, Fig.2A; Figs.18, 20) ; the received data includes a plurality of sets of information identified by the form number or serial number (11' or 12', Fig.2C), the received data includes common data for associating said common data with each of said plurality of generated documents (Fig.2A; col 10, lines 10-36), at least one of said sets of information include an indication indicates special processing for one of the plurality of forms which includes means for changing a format of at least a portion of the form, means for attaching an additional message to the form, means for inserting the plurality of values in the single data field (Figs. 8, 9, 14, 20; col 7, lines 20-59; col 10, line 66 - col 11, line 54; col 15, lines 11-14); the populating means is for separating the plurality of fields from the data based on a special indicator (Figs.4, 8, 9; col 12, lines 8-43; col 13, line 34 - col 14, line 11; col 14, line 48 - col 15, line 14); the data includes a definition record including an ordered listing of identifiers for each of the data fields being supplied in the data (Figs.4, 5; col 5, line 60 - col 6, line 36; col 6, line 47 - col 7, line 32; col 8, lines 12-36; col 12, line 8 - col 13, line 4; col 14, line 48 - col 15, line 14).

Art Unit: 2616

4. Concerning claim 11, Huang fails to teach that the specific character is a comma. However, Huang teaches the character recognition processor (26, Fig.1B) which can recognize the characters including the comma. In addition, the use of the dash (-) (Fig.18), slash (/) the “\$” sign, the dot (.) (Fig.20) to allow the OCR to distinguish different information show that the use of a comma is possible. It would have been obvious to one skilled in the art at the time the invention was made to include the use of a comma as special character to separate pieces of information.

5. Claims 15-22 are method claims corresponding to apparatus claims 1-14. Therefore, claims 15-22 are rejected for the same rationales set forth for claims 1-14.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Bloomberg (US Patent No. 5572601) teaches a mark sensing on a form for locating a particular portion of an image and extracting mark-sense information.
- b. Yaksich et al (US Patent No. 5563999) discloses a forms automation system for large users of business forms having multiple use locations.

Art Unit: 2616

c. Millman et al teaches fax machine having automated maintenance features for paper vendor order information.

d. Karnik (US Patent No. 5404294) discloses a tag method for moving information between computers and forms.

e. Anderson (US Patent No. 4941685) teaches multiple part facsimile form preferably by carbonless transfer.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Madeleine Anh-Vinh Nguyen whose telephone number is (703) 305-4860. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703)-305-4712. The fax phone number for this Group is (703) 308-5397 or (703)-305-5397.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



EDWARD L. COLES, SR.  
SUPERVISORY PATENT EXAMINER  
GROUP 2600

Madeleine Anh-Vinh Nguyen  
August 28, 1997